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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 09/654,735 | 09/05/2000 | Donald R. Titterington | D/A0306II | 8428 |

21567 7590 12/31/2002

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EXAMINER

SERGEANT, RABON A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1711

DATE MAILED: 12/31/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/654,735

Applicant(s)
Titterington et al.

Examiner
Rabon Sergeant

Art Unit
1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 23, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 39-44 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 39-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other: _____

Art Unit: 1711

1. Claims 3-5, 9-11, and 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The alcohol species should be recited in the alternative.

2. Claims 39-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Firstly, the use of "comprise" to define the "R" and "X" groups renders the claims indefinite, because it unclear what additional species are encompassed by the variables.

Secondly, the use of "can be" renders the claims indefinite, because it is unclear if or to what extent the language denoted by "can be" is optional.

Thirdly, within claim 39, the language, "can be comprised", is ambiguous. It is unclear what applicants are trying to claim, and it is improper to use "comprised" within the definition of variables.

Fourthly, X_1 , X_2 , and X_3 are not present within the structures.

Lastly, x, y, and z have not been defined.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants have provided enablement only for the use and production of non-

Art Unit: 1711

polymeric urethanes; however, it is unclear that applicants' claimed urethanes exclude polymeric products.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 6-12, 15, and 39-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-38 and 43-45 of copending Application No. 09/078,190. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

Art Unit: 1711

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-20 and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-58 of U.S. Patent No. 5,994,453. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

7. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 5, 16, and 17 of U.S. Patent No. 5,750,604. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

8. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 5 of U.S. Patent No. 5,782,966. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

9. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 6, 11, 12, 23, 24, 29, and 30 of U.S. Patent No. 5,783,658. Although the conflicting claims are not identical, they are not

Art Unit: 1711

patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

10. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 27-29 of U.S. Patent No. 5,827,918. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

11. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 6-10, 16, 17, 23-30, 33, 35-39, 49, and 50 of U.S. Patent No. 5,830,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

12. Claims 6-12, 15, and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 10, 13, 14, 32, 33, 36, and 37 of U.S. Patent No. 5,919,839. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

13. Claims 1-20 and 39-44 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 8, 9, 12, and 34 of U.S. Patent No. 6,057,399. Although the conflicting claims are not identical, they are not patentably

Art Unit: 1711

distinct from each other because each claim set is drawn to a phase change ink composition comprising a urethane derived from a fused ring alcohol.

Any inquiry concerning this communication should be directed to R. Sergeant at telephone number (703) 308-2982.

R. Sergeant

December 30, 2002


RABON SERGENT
PRIMARY EXAMINER